

spectrum obtained for the claimed compound thus evidence that the claimed compound is a different chemical entity than a mixture of the two active substances.

Indefiniteness Rejection of Claim 17 under 35 U.S.C. §112, Second Paragraph

The Office Action asserts that claim 17 reads on a physical mixture. This is incorrect. The language of claim 17 specifically recites "a compound of tramadol hydrochloride and diclofenac sodium." This claim language makes it clear that a compound is present and distinguishes the claimed invention from a simple mixture of tramadol hydrochloride and diclofenac sodium. The fact that the claimed compound can be decomposed to release tramadol and diclofenac does not mean that the claim reads on a mixture, nor does it make the claim indefinite in any way. The claim is clearly directed to a compound formed *in situ* of tramadol hydrochloride and diclofenac sodium and the meaning of this claim language is not unclear in any way. The fact that the Examiner may have doubts as to whether a compound is actually formed would be an issue of enablement, not claim definiteness, but in any event the Declaration evidence clearly shows that a compound is formed. Reconsideration and withdrawal of the indefiniteness rejection are respectfully requested.

Rejection of claim 17 under 35 U.S.C. §102(e) over Mauskop, US 5,914,129

As noted above, claim 17 is directed to a compound formed of tramadol hydrochloride and diclofenac sodium. Mauskop does not disclose any such compound. Mauskop merely discloses compositions comprising a mixture of a non-opioid analgesic selected from a first list of 17 possibilities and an opioid analgesic selected from a second list of 16 possibilities. Mauskop does not even disclose a mixture of tramadol hydrochloride and diclofenac sodium, rather a skilled worker would have to make appropriate selections from the disclosed lists to come up with such a mixture. In any event, the claim does not read on a simple mixture as suggested by Mauskop. Thus Mauskop is clearly not

anticipatory of the claimed invention. Reconsideration and withdrawal of the rejection are accordingly respectfully requested.

Rejection of claim 38 under 35 U.S.C. 103(a) over Mauskop, US 5,914,129

Claim 38 is directed to a method of making the claimed compound formed of tramadol hydrochloride and diclofenac sodium comprising repeated mixing and moistening followed by formulation under an energy input. As noted above, Mauskop merely discloses forming a tablet from a mixture of an opioid analgesic and a non-opioid analgesic which if properly selected from lists of possible analgesics might be a mixture of tramadol and diclofenac. As acknowledged in the Office Action, Mauskop does not describe repeating mixing and moistening steps, nor does Mauskop mention formulation under an energy input. The rejection surmises that it would be obvious to repeat the mixing and moistening steps and to formulate under an energy input in order to obtain a desired composition, but the rejection fails to explain why Mauskop would lead one skilled in the art to desire to make a compound formed of tramadol hydrochloride and diclofenac sodium as claimed by applicants. Neither Mauskop nor any other evidence of record discloses or suggests the possibility, much less the desirability, of making such a compound. Nor is there any explanation what purpose would be served by repeating the mixing and moistening steps or why a person skilled in the art would find it obvious to go to the trouble and expense to repeat such steps when no purpose would be served. The rejection thus fails to state a proper, *prima facie* case of obviousness.

Moreover, even if a *prima facie* case had been made out, it would be rebutted by the declaration evidence of record. The Declaration evidence shows that a tablet containing the compound formed of tramadol hydrochloride and diclofenac sodium produced by the method of the invention has an unexpectedly superior slower release profile compared to a tablet formed from a mixture of tramadol hydrochloride and diclofenac sodium produced according to the teachings of Mauskop. (See, e.g., paragraph 5.I.(d) of the Declaration). This

unexpectedly improved release profile obtained by the claimed invention could not have been expected or predicted based on the teachings of Mauskop and effectively rebuts any argument that the claimed invention would have been obvious in view of Mauskop. Reconsideration and withdrawal of the rejection are respectfully requested.

#### Obviousness-Type Double Patenting Over US 2005/0003002 A1

This obviousness-type double patenting rejection over co-pending application no. 10/837,755 is believed overcome by the accompanying Terminal Disclaimer.

#### Summary and Conclusion

The Declaration evidence clearly establishes that the claimed product comprising a compound formed of tramadol hydrochloride and diclofenac sodium produced by the claimed method is chemically different from a mixture of tramadol hydrochloride and diclofenac sodium in that it has both a different release profile and a different DSC spectrum. The claimed product thus is not anticipated by the mixture of Mauskop, nor is the claimed method rendered obvious by the teachings of Mauskop. Moreover, any case of obviousness which might be thought to exist is effectively rebutted by the Declaration evidence of record showing that the claimed product comprising a compound formed of tramadol hydrochloride and diclofenac sodium produced by the claimed method has an unexpected and surprising superior release profile. The claimed product and method are thus respectfully submitted to be patentable, and prompt, favorable action on the application is earnestly solicited.

If there are any questions about this Reply or the application in general, a telephone call to the undersigned at (202) 624-2845 would be appreciated, since this should expedite examination of the application for all concerned.


If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and

Application No. 10/084,676  
Reply to Office Action  
April 13, 2007

please charge any deficiency in fees or credit any overpayments to Deposit  
Account No. 05-1323 (Docket # 029310.50932).

Respectfully submitted,

April 13, 2007

  
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